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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,814	01/22/2004	David Bau	BEAS-01388US1 SRM/DTX	6120
23910 7590 01/16/2007 FLIESLER MEYER LLP 650 CALIFORNIA STREET 14TH FLOOR SAN FRANCISCO, CA 94108			EXAMINER KHATRI, ANIL	
			ART UNIT 2191	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/16/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/762,814

Applicant(s)

BAU, DAVID

Examiner

Anil Khatri

Art Unit

2191

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/2/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

The disclosure is objected to because of the following informalities: Needs applications numbers co-pending applications in Cross Reference to Related Documents.

Appropriate correction is required.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "*Marshaling and Un-Marshaling Data Types in XML and Java*".

The use of the trademark Java, DCOM, Beans etc. has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-66 are rejected under 35 USC 101 because they disclose a claimed invention that is an abstract idea as defined in the case *In re Warmerdam*, 33, F 3d 1354, 31 USPQ 2d 1754 (Fed. Cir. 1994).

*Analysis:* Claims 1-66 disclosed by the applicant as being a “marshal and un-marshal data between XML and Java...”. Since the claims are each a series of steps to be performed on a computer the processes must be analyzed to determine whether they are statutory under 35 USC 101.

Examiner interprets that the claims 1-66 are non-statutory because they do not disclose that how a system will be able to marshal and un-marshal XML and Java data and process and execute them without incorporating a processor, memory and medium. Further, claims are merely manipulation of data structure and schema without producing any tangible results so its functionality can be realized. Therefore, claims 1-66 are non-statutory and rejected under 35 USC 101.

*Analysis:* Further, examiner interprets that the claims 44-64 and 66 are non-statutory because applicant cited claims are “a computer readable storage medium having and data signal...”. Since the claims are each a series of steps to be performed on a computer the processes must be analyzed to determine whether they are statutory under 35 USC 101.

Claims 44-64 and 66 are not limited to tangible embodiments since medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., [computer readable medium]) and intangible embodiments (e.g., [transmission media, radio frequency (RF), infrared (IR), a carrier wave, telephone line, a signal, etc.]). As such, the claim is not limited to statutory subject matter and is therefore non-statutory. To overcome this type of 101 rejection the claims need to be amended to include only the physical computer media and not a transmission media or other intangible or non-functional media. For the specification

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carrier medium and transmission media would be not statutory but storage media would be statutory.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims rejected under 35 U.S.C. 102(e) as being anticipated by *Slaughter et al* USPN

6,918,084.

Regarding claims 1, 15, 18, 19, 23, 37, 40, 41, 44, 58, 61, 62, 65 and 66

*Slaughter et al* teaches,

an XML data (figures 10, 34, 35, column 7, lines 46-57, “a distributed... results”);

an XML schema which defines the XML data (figures 10, 34, 35, column 7, lines 62-67,

“include an XML schema...);

an XML type which is a Java type capable of accessing the XML data within Java (figures 2, 10, 34, 35, column 15, lines 1-14, “extensible mark up... object itself”) ; and

a compiler capable of generating the XML type from the XML schema (figures 35, column 25, lines 59-67, “ a generation tool... are desired”).

Regarding claims 2-4, 13, 24-26 and 45-47

*Slaughter et al* teaches,

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the compiler is capable of generating the XML type based on the definition of a Java web services method (figures 5, 34, 35, column 75, lines 58-67, “creating and sending XML...”, column 76, lines 5-22, “Java object... be used).

Regarding claims 5, 6, 27, 28, 48 and 49

*Slaughter et al* teaches,

the XML type can be a movable cursor, capable of reading anywhere within the XML data (column 55, lines 11-31, “the publishing device... local network).

Regarding claims 7-12, 14, 22-29-36, 42, 43, 50-57 and 64

*Slaughter et al* teaches,

the XML type can be shared among multiple Java components (figures 2, 10, 34, 35, column 15, lines 1-14, “extensible mark up... object itself”).

Regarding claims 16, 17, 38, 39, 59 and 60

*Slaughter et al* teaches,

a global registry of XML transformations capable of looking up transformation between a source and a target type (column 58, lines 44-55, “the distributed... components”, column 59, lines 31-40, “data called contents..”).

an existing XML (figures 10, 34, 35, column 7, lines 62-67, “include an XML schema...).

Regarding claims 20, 21, 63 and 64

*Slaughter et al* teaches,

the lightweight XML store is capable of representing the retained XML data as a hierarchical structure (figures 21, 36 and 37, column 44, column 74, lines 48-67, “the hierarchical structure of XML...”).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anil Khatri whose telephone number is 571-272-3725. The examiner can normally be reached on M-F 8:30-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Zhen can be reached on 571-272-3708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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**ANIL KHATRI**  
**PRIMARY EXAMINER**